

U.S.S.N. 09/420,877

- 8 -

AIT 0127 PA (A00463)

REMARKS

Examiner's comments in the Office Action dated June 17, 2004 have been carefully considered by Applicants. In view of such comments, Applicants have amended the claims as set forth herein. In particular, independent claims 1, 10, and 14 have all been amended to better highlight the patentable differences of Applicants' proposed invention as compared to the prior art cited and interpreted by Examiner in the Office Action. In making such amendments, Applicants maintain that no new matter has been introduced into the present application. Furthermore, no claims have been altogether cancelled, and no entirely new claims have been added. Thus, claims 1 through 20 remain pending in Applicants' present application. It is Applicants' good faith belief that the pending claims, as amended, are both novel and non-obvious. Therefore, Applicants respectfully maintain that the pending claims now place the present application in condition for allowance and notice thereof is respectfully requested.

35 U.S.C. § 102(e)

In the Office Action, independent claims 1, 10, and 14 and dependent claims 2, 5-9, 11-13, and 15-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated and therefore unpatentable over United States Patent Number 6,226,744, issued to Murphy *et alia* on May 1, 2001 (hereinafter "Murphy"). Applicants respectfully traverse each of these 35 U.S.C. § 102 rejections set forth in the Office Action in view of the claims as amended, for Applicants' invention as presently claimed is deemed novel in light of the prior art cited by Examiner.

In general, the Murphy reference is primarily concerned with authenticating a user over a network that provides restricted access to information that is stored on a server. To authenticate a user, Murphy teaches use of a strong cryptographic key by employing intelligence and stored user information on a smart card. Other than authentication information and miscellaneous restricted information, references to stored information in Murphy largely refer to user information that is directly stored on

U.S.S.N. 09/420,877

- 9 -

AIT 0127 PA (A00463)

the smart card itself. That is, the Murphy system is not concerned with attempting to store user information on a central database server or in any other largely centralized manner. Instead, the Murphy system mainly concerns storing significant amounts of user information directly on a smart card so that a user may utilize the card for user authentication purposes in order to gain access, for example, to a restricted web site or computer network.

In contrast, Applicants' invention concerns a server architecture wherein data or information related to an individual smart card user is stored in a largely centralized manner. In centralizing the storage of such information in this manner, user information can be accessed, when properly authorized, by the individual smart card user himself or by pre-defined groups of vicarious users of the card such as merchants, the authorized user's doctor, the authorized user's family members, business associates, or even selected segments of the general public. In other words, Applicants' invention is not primarily focused on the user authorization aspects or authentication concerns of smart cards and smart card terminals. Instead, Applicants' invention is more concerned with providing a database architecture that can store large amounts of user information in a largely centralized manner so that all such user information can be easily accessed through the simple use of a smart card. In this way, the smart card essentially functions as a "key" which is able to "unlock" large amounts of data and information associated with a given smart card user for various different smart card transactions and applications.

To facilitate indexing and retrieval of such smart card user information pursuant to Applicants' invention, the user information is stored in partitioned memory locations within a central server or a largely centralized group of servers. In this way, user information is both stored and accessed according to (1) application/transaction type (for example, medical information, financial information, et cetera) and (2) designated accessibility/security level (for example, restricted access, limited public access, unrestricted public access, et cetera). To ensure that a user smart card is able to "unlock" as much user information as is possible, a smart card pursuant to Applicants'

U.S.S.N. 09/420,877

- 10 -

AIT 0127 PA (A00463)

invention has an on-card memory that, for the most part, only stores (1) a user authorization/authentication code and (2) one or more memory-economizing data pointers. When the smart card is inserted in a smart card terminal, the data pointers are utilized to index and retrieve user information that is stored off-card within a central server or a largely centralized group of servers. By primarily storing mere data pointers instead of a significant amount of actual user information or data within the smart card's memory, space within the smart card's memory is thereby conserved and economized to allow for many numerous data pointers to be stored therein. In this way, a smart card pursuant to Applicants' invention can be utilized to access larger amounts of user information than could be accessed if the card stored a significant amount of actual space-consuming user information on-card.

By the foregoing amendments to claims 1 through 18, Applicants respectfully maintain that differences between Murphy and Applicants' invention have been sufficiently highlighted so as to render both independent claims 1, 10, and 14 and dependent claims 2, 5-9, 11-13, and 15-20 novel in view of Murphy.

In particular, Independent claim 1 is distinguished from the Murphy reference because the claim recites a central database server that includes a plurality of partitioned memory locations wherein at least one of the partitioned memory locations contains information associated with an authorized user of a smart card, the information being accessible by a smart card terminal via memory-economizing data pointers contained in the card. As an initial matter, Applicants respectfully traverse the suggestion in the Office Action that the Murphy reference teaches a plurality of partitioned memory locations as defined in the present application. Admittedly, the Murphy reference discloses a memory module which might be any type of machine readable storage device such as a RAM or ROM. The partitioned memory locations as claimed in Applicants' invention, however, are associated with an authorized user of the smart card and are configured, for example, such as representatively shown in Figure 3. The Murphy reference does not disclose partitioned memory locations wherein at least one of the memory locations contains information associated with an authorized user of

U.S.S.N. 09/420,877

- 11 -

AIT 0127 PA (A00463)

a smart card. For example, the only information referred to as being stored in the secure gateway server disclosed in Murphy is authorization information, such as a user's social security number which is matched with user information stored on a smart card.

Furthermore, the present claims refer to the information stored at the central server as being accessible by the smart card terminal via memory-economizing data pointers contained in the smart card, which the Murphy reference does not disclose or suggest. In all instances in the Murphy reference, information from the card is accessed and compared with server information to authorize a user. Thus, in the system of Murphy, all information regarding a user of the smart card is contained on the smart card itself other than authorization information which may also be stored elsewhere in the network to provide the smart card user access to restricted sites requiring authorization. In contrast, Applicants' invention concerns a centralized information database for a smart card user which can be accessed once the user is authorized to access the system. In other words, the present invention concerns smart card use post-authorization, whereas the Murphy reference concerns the authorization process for using a smart card. By storing most of the user information off the smart card and in a card-accessible centralized database, Applicants' invention can prevent unnecessary redundancies and/or undesirable inaccuracies in user information and also provide access to larger amounts of user information.. For example, rather than having the user's smart card itself contain memory-consuming information regarding the user's bank account balances, the smart card instead merely contains a memory-economizing data pointer for accessing the user's bank server such that the user can have access to the most up-to-date information regarding his bank account balances. As a further confirmation of the timeliness of the information pointed to by the smart card, the network can also include a time and dating authority as cited in dependent claim 2 to make a temporal association with the data under consideration, which the Murphy reference neither teaches nor suggests.

U.S.S.N. 09/420,877

- 12 -

AIT 0127 PA (A00463)

With regard to dependent claims 5 and 6, Applicants respectfully maintain that they are novel (and non-obvious) for at least the same reasons as set forth hereinabove with respect to independent claim 1.

Dependent claims 7 and 8 have been amended to clarify that the partitioned memory locations include different security levels of data associated with the authorized user of the smart card which the Murphy reference does not disclose or suggest. Though somewhat similar to both dependent claims 7 and 8, dependent claim 9 as amended additionally refers to the partitioned memory locations on the central server as supporting different smart card applications. Such application-specific partitioned memory locations is neither taught nor suggested in Murphy and is different from the Examiner-cited portion of the Murphy reference which refers to data stored on the smart card which may be used to authenticate a user of the smart card.

Independent claim 10 has been amended to highlight that various types of user information are stored in a plurality of application-specific partitioned memory locations at a centralized source wherein the information is related to an authorized user of the smart card. Such differs from the cited portions of the Murphy reference referred to in the Office Action which all relate to various types of authorization information which can be stored on the smart card to identify a user. For at least these same reasons, Applicants respectfully maintain that claims 11 through 13, which are directly dependent on claim 10, are novel notwithstanding the Murphy reference.

Independent claim 14 somewhat similarly requires that a smart card server contain application-specific partitioned memory locations for containing information relating to an authorized user of a smart card and that the smart card contain data pointers for pointing to the user's information contained within these memory locations at a centralized server or plurality of servers. Again, the only common information between the smart card and the server referred to in the Murphy reference is authorization information. All of the user information in Murphy is, otherwise, contained on the card itself. For at least these same reasons, Applicants respectfully maintain that

U.S.S.N. 09/420,877

- 13 -

AIT 0127 PA (A00463)

claims 15 through 20, which are at least indirectly dependent on claim 14, are novel notwithstanding the Murphy reference.

35 U.S.C. § 103(a)

In the Office Action, dependent claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being obvious and therefore unpatentable over United States Patent Number 6,226,744, issued to Murphy *et alia* on May 1, 2001 ("Murphy"), in view of United States Patent Number 6,038,551, issued to Barlow *et alia* on March 14, 2000 ("Barlow"). Applicants respectfully traverse each of these 35 U.S.C. § 103 rejections set forth in the Office Action in view of the claims as amended, for Applicants' invention as presently claimed is deemed not merely an obvious improvement over the prior art cited by Examiner.

With general regard to Examiner's rejections under 35 U.S.C. § 103, Applicants respectfully maintain that rejection for obviousness must be based upon objective evidence of record and requires that particular findings be made as to why a skilled artisan with no knowledge of the claimed invention would have selected the specific components for combination in the manner claimed. Thus, in order for any prior art references themselves to be validly combined for use in a prior art obviousness rejection under 35 U.S.C. § 103(a), the references themselves, or some other piece of prior art, must suggest that they be combined. *In re Sernaker*, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983). That is, the suggestion to combine the references must not come from the Applicants' proposed invention itself. *Orthopedic Equipment Co. v. United States*, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983). In sum, in order to establish a *prima facie* case of obviousness, it is necessary to present evidence, in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. *Ex parte Levengood*, 28 U.S.P.Q.(2d) 1300 (P.T.O.B.A.&I. 1993).

U.S.S.N. 09/420,877

- 14 -

AIT 0127 PA (A00463)

With regard to the obviousness rejection of dependent claims 3 and 4, Applicants submit that the combination of Murphy and Barlow would not render obvious Applicants' claimed invention, for those references, either alone or in combination, neither teach nor suggest all of the claimed features of Applicants' invention. In particular, neither Murphy nor Barlow teaches or suggests a "smart card applications network" having a "central database server" with "partitioned memory locations" that is suited "for use with a smart card terminal in combination with a smart card" that contains "memory-economizing data pointers," as is recited in Applicants' independent claim 1 upon which both claims 3 and 4 are dependent.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that independent claims 1, 10, and 14 as amended, as well as claims 2-9, 11-13, and 15-20 dependent thereon, are both novel and nonobvious with respect to the disclosures and teachings of Murphy and Barlow. Therefore, Applicants respectfully request that Examiner's rejections under both 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) be withdrawn and that a Notice of Allowance be issued therefor.

Entry and reconsideration of the claims as herein amended is respectfully requested under 37 C.F.R. § 1.116(c) in view of Examiner's newly-introduced detailed comments in the June 17, 2004 Office Action marked as being final. At the very least, in submitting this proposed amendment within two months of the mailing date of the Office Action, Applicants hereby respectfully request an advisory action from Examiner, and that these amendments be entered.

U.S.S.N. 09/420,877

- 15 -

AIT 0127 PA (A00463)

Should the Examiner have any questions with respect to any matter now of record, the Examiner is invited to contact Applicants' undersigned attorney at (248) 223-9500.

Respectfully submitted,

ARTZ & ARTZ, P.C.



Robert P. Renke, Reg. No. 40,783
28333 Telegraph Road, Suite 250
Southfield, MI 48034
(248) 223-9500

Dated: August 17, 2004